Supreme Court U.S.
FILED
MAR 15 2002
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(3)

No. 01-917

In The

Supreme Court of the United States

ROGER W. BROWN, Ph.D.,

Petitioner,

v.

3M and AIR PRODUCTS AND CHEMICALS, INC.,

Respondents.

On Petition For Writ Of Certiorari To The United States Court Of Appeals For The Federal Circuit

REPLY BRIEF

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I. The Majority and the Dissent interpreted Dr. Brown's patent claim in the same way.

3M's Brief in Opposition is misleading in its claim that the difference between the majority and the dissent in the Federal Circuit is a difference of claim interpretation. The Federal Circuit majority opinion and dissenting opinion interpret claim 16 of Dr. Brown's patent in exactly the same way.

The Federal Circuit majority opinion interpreted claim 16 of Dr. Brown's patent as the District Court interpreted it: an apparatus that can convert any combination of two-digit, three-digit, or four-digit year date formats.

> The district court construed the word "or" in claim 16 as meaning that the apparatus was capable of converting 'only two-digit, only three-digit, only four-digit, or any combination of two-, three-, and four-digit date-data.' Slip op. at 9. We agree with this construction of the claim, for it is the plain reading of the claim text.

App. 5.

This is also the interpretation given by Judge Mayer in the Federal Circuit Dissent:

> Such data representations may consist of only two-digit dates, only three-digit dates, only four-digit dates, or any combination or sub-combination thereof. Therefore, although the data may vary, the mechanism always must have the capacity to convert all of the possible data sets into two-digit year-date data representations.

Both the majority and the dissent agreed that Dr. Brown's apparatus had the capability of converting any combination of year dates. Both the majority and the dissent referred to that capability as one that the prior art lacked. The majority referred to, "the larger capacity of the Brown system to conduct three- and/or four-digit date conversion." The dissent concluded that "the Brown patent teaches an apparatus with additional functionality not disclosed in the allegedly anticipating TOCS patent." App.7

It was only the application of two different tests to this claim interpretation that led to two different opinions regarding anticipation.

II. This issue was raised below.

The issue presented in this petition was presented to the Federal Circuit below. It is important to note that in the Federal Circuit, Dr. Brown's opening brief was entirely dedicated to exposing the District Court's mistake in holding that the prior art TOCS patent taught remediation of three- and four-digit date representations (as opposed to only two-digit year dates). In response, 3M argued that even if the District Court was wrong in its interpretation of the TOCS claims, the TOCS patent still anticipated.

3M urged the Federal Circuit to find anticipation because "that which infringes if later, anticipates if earlier." 3M reasoned that since Dr. Brown's claim was written in the alternative (two-, three-, or four-digit year

dates), infringement would occur even though the TOCS device only converted two-digit year dates.

In reply, Dr. Brown agreed that the claim was written in the alternative, but urged the Federal Circuit to find there was no anticipation because "to invalidate a patent by anticipation, a prior art reference needs to disclose each and every limitation of the claim." The TOCS patent did not disclose the ability to convert three- and four-digit year dates, and thus, did not anticipate.

Since 3M urged one test and Dr. Brown urged the other test, the issue of which test to apply was raised below. The majority chose to apply the rule urged by 3M while the dissent chose to apply the rule urged by Dr. Brown.

It would have been futile for Dr. Brown go beyond urging the Federal Circuit to apply the correct rule and actually ask the Federal Circuit to reject a rule that was adopted by this Court. Even if the Federal Circuit was inclined to reject the rule "that which infringes if later anticipates if earlier," it would have been beyond the authority of the Federal Circuit to do so. *See Senza-gel Corp. v. Seiffhart*, 803 F.2d 661, 665 n.5 (Fed. Cir. 1986) (Federal Circuit is bound to adhere to existing Supreme Court guidance unless otherwise directed by Congress or the Supreme Court).

III. The *Lewmar* Case

In the case of *Lewmar Marine, Inc. v. Barient, Inc.*, 827 F.2d 744 (Fed. Cir. 1987), the Federal Circuit did encounter the conflict between the two different rules of anticipation. In *Lewmar*, however, the Federal Circuit was able

to resolve the conflict by recognizing that statutory changes in the definition of the word "anticipates" warranted narrowing "the classic test" to read "that which *literally* infringes if later, anticipates if earlier." *Id.* at 747-748.

Here, unlike in *Lewmar*, narrowing "the classic test" to include only literal infringement will not solve the conflict between the rules. Here, the two rules simply can not be harmonized because the prior art TOCS patent may literally infringe the claims of the Brown patent, but it does not fully disclose them. In the case at bar, the only way to resolve the conflict between the two rules is to choose one over the other.

The *Lewmar* case does demonstrate that when the Federal Circuit has encountered a conflict between the two rules, it has sought to resolve the conflict without sacrificing the integrity of the true rule of anticipation – that to anticipate, a prior art reference must disclose each and every limitation of the claim.

CONCLUSION

The public has an interest in promoting technological progress through patent protection for distinct improvements over existing inventions. This Court should issue a writ of certiorari and exercise its sole authority to restrict the use of a widely cited rule which harms that public interest.

Respectfully submitted,

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